

REMARKS

General remarks

Claims 21, 22, 24, & 25 are all the claims pending in the application. Claim 23 has been canceled, without prejudice or disclaimer.

The rejection under 35 U.S.C. section 112, 2d paragraph is respectfully submitted to be overcome by the cancellation of the allegedly indefinite claim 23.

Claim amendments

The amendments to independent claim 21 contain no new matter, and are respectfully submitted to broaden the claim scope and put the claims in a desired form for possible future appeal if necessary.

The rejection over Forward in view of Good

The Examiner rejected all the claims under 35 U.S.C. § 103(a) as being unpatentable over Forward in view of Good. The rejection is respectfully traversed.

In the response filed on January 20, 2006, Applicant pointed out several important distinctions between a real estate sales method for new home developments (as in Forward) and the claimed real estate rental method. Applicant noted that Forward focuses exclusively on sales, while claim 21 specifically targets rental real estate.

Applicant also pointed out that the rental and sales markets are completely different, having in common only the fact that real estate is involved. Applicant described the difference in fee structures and arrangements, and the important effects these differences cause.

In addition, Applicant noted for the Examiner's benefit that Forward seeks to eliminate fees paid to brokers that increase the net cost to the builder and reduce builder's project financing costs, and that this approach leads to a flaw that makes the Forward patent's approach unsuitable for the rental market.

Moreover, Applicant highlighted that there are significant transactional differences (between real estate sales and real estate rentals) that make the Forward approach one that the artisan of ordinary skill would not have adopted for use in a rental context.

To compensate for the foregoing deficiencies vis-à-vis independent claim 21, the Examiner recast the rejection under 35 U.S.C. § 103(a) in view of Forward and Good. Good relates to real estate rentals.

The Examiner characterized Good in the following manner:

While Forward does not specifically state that the invention is for rental real estate, the analogous teachings of Good et al. describe a similar real estate transaction method that is used in rental transaction. The method disclosed in Good et al. contain a broker computer system which accepts rental property search criteria from a customer, returns rental real estate descriptions, receives confirmation that a user entered a lease agreement, collects a fee from the lessor, and provides the customer with an inducement (Good et al. Col 3, line 44 through Col 4, line 20 and Col 5, line 63 through Col 6, line 26). Therefore, it would have been obvious for one

Although Applicant does not think the Examiner intentionally mischaracterized Good, Applicant respectfully submits that the Examiner's characterization of Good is more generous than Good's actual teachings warrant. Good may be more accurately summarized as follows:

- 1) broker promises potential tenant an inducement benefit package if lease is signed (col. 3, lines 62-65);
- 2) buyer selects particular apartment complex (col. 3, lines 49-52);
- 3) computer system allows user to print out on paper a referral agreement indicating apartment complex and the user (col. 3, lines 55-58);
- 4) potential tenant and lessor manually execute lease and also sign referral agreement (col. 3, lines 59-62);
- 5) lessor provides signed (paper) referral agreement to broker (col. 3, line 59 and col. 6, lines 40-46);

- 6) if agreement has been received by broker, tenant gets incentive (col. 3, lines 62-65 and col. 6, line 45).

Applicant respectfully points out that Good lacks any teaching or suggestion as to the incentive, other than that it was previously promised.

The combined teachings of Forward and Good compared with independent claim 21

The Examiner asserted that the Forward / Good combination is an obvious one. In particular, the Examiner wrote:

Col 5, line 63 through Col 6, line 26). Therefore, it would have been obvious for one of ordinary skill in the art at the time of the invention to include rental properties in the type of real estate transactions method disclosed by Forward. One would have been motivated to include rental properties in order to increase the volume of properties from which a customer can select, as well as increase the potential brokers revenue generating opportunities. Another motivation for including rental properties in the invention would be that such an inclusion would merely be an addition to the disclosed intended use and require little to no modification to the system disclosed.

Notwithstanding the Examiner's remarks, Applicant respectfully points out that no convincing motivation has been provided by the Examiner for the suggested combination.

Forward and Good would not have been thought by the artisan of ordinary skill to be combinable. The Examiner asserted that the artisan of ordinary skill would have been motivated to include rental properties in order to increase the volume of properties from which a customer can select, but this ignores the fact that Forward is drawn to a method by which a builder can sell its own homes in a new development without having to pay a commission to a broker. It would not make sense for the builder to suddenly try to add listings of competing rental apartments. Why would a builder of new homes want to do such a thing? What would have led the artisan of ordinary skill to modify Forward in such an illogical manner?

The Examiner asserted that the artisan of ordinary skill would have been motivated to include rental properties in Forward's system under the theory that such an inclusion would merely be an addition to the disclosed intended use and require little to no modification. This is akin to asserting that the modifications necessary would be easy to do. The ease of modifying one system to create another, however, is truly unrelated to whether the motivation to make such a modification exists. Many improvement patents result from modifications that are not remarkably difficult, but that are non-obvious.

By stating that the inclusion of rental properties would merely be an addition to a disclosed intended use, the Examiner is actually noticing Applicant's point about Forward. Forward doesn't teach a method that relates in any way to real estate rentals ... the inclusion of real estate rentals is "an addition" (meaning --not taught--). The use of Forward in a real estate context is *not within the intended use* of the patent, and, ergo, it must be *an addition*.

Regarding the request for suspension of prosecution

Applicant thinks that the Examiner has not fully grasped the differences between the real estate rental and real estate sales environments, and does not understand that Forward constitutes substantially non-analogous art.

Applicant has requested a suspension of prosecution for a period of three months so that Applicant has time to collect, organize, and submit evidence that may equip the Examiner with the facts necessary to make a proper decision as to the patentability of the claims. It is Applicant's present plan to submit such evidence, together with a declaration, for the Examiner's benefit. Therefore, it is respectfully requested that the petition for the suspension of prosecution be granted.

Dependent claims

Dependent claim 22 requires a discount code that is used when the rebate is obtained.

Neither Forward, nor Good, nor their combined teachings makes any mention whatever as to the use of a discount code. The combined teachings of Forward and Good lack any mention

of assigning a discount code at all, let alone a discount code that is associated with a selected one of the apartments.

The use of the discount code provides important flexibility to the system and streamlines processing, and although both Forward and Good represent certain advances in the art, neither contemplates such an improvement.

In the above-identified Office Action, the Examiner never said that Forward, Good, or their combined teachings taken as a whole mention (1) a discount code, or (2) a discount code associated with an apartment selection, or (3) a discount code used when the rebate is obtained. No, the Examiner never asserted that the prior art teaches any of these items.

Instead, in the above-identified Office Action, the Examiner asserted that "the incentive information inherently contains a specific code in order for the system to match the correct incentive with the proper customer".

Applicant respectfully disputes this point. There is no evidence in the record (or in any prior art document known to Applicant) supporting the Examiner's position on inherency. As the Examiner will appreciate, prior art rejections must be based on prior art evidence, not the opinions or feelings of the examining corps.

Applicant understands that the basing of a rejection on inherency may, in some very limited circumstances, be appropriate.

"A rejection under 35 U.S.C. § 102/103 can be made when the prior art product seems to be identical except that the prior art is silent as to an inherent characteristic" (MPEP, §2112).

The MPEP points out, however, that "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." (MPEP §2112, citing with approval *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993)). Furthermore, "[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of

the applied prior art.” (MPEP §2112, citing with approval *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. Appendix. & Inter. 1990)). (emphasis in MPEP).

Here, the Examiner has presented no reasoning and no evidence tending to show inherency. In other words, the Examiner has not shown that the use of a discount code (assigned to the user, associated with a selected one of the apartments, ... used when the rebate is obtained) necessarily flows from the Forward, or the Good, or any other reference.

Applicant notes the discussion of an incentive module in col. 8, lines 1-10 of Forward. Applicant sees that a data structure may be used to store incentive information. Applicant understands that it is common to use key fields or id fields to store items in rows of a database so as to have a unique identifier. Perhaps the Examiner is thinking of such items when the Examiner asserts inherency. If the Examiner is thinking along these lines, Applicant then respectfully points out that such key fields or id fields are unique identifiers for database entries, and not discount codes. The fact that some database systems use such key fields or id fields does not, however, even make their existence inherent. Database systems permit systems programmers to set up tables without such fields, and thus the presence of even these unrelated kinds of internal database fields is not inherent.

Since the requirements relating to the discount code, as set forth in claim 22, are entirely unmet by any prior art reference of record, and since the Examiner's assertions as to inherency are entirely unsupported by any evidence, and since the MPEP correctly states the current law as to inherency, Applicant respectfully requests the Examiner to kindly reconsider and to withdraw the rejection of independent claim 22.

The rejection of dependent claim 25

As to dependent claim 25, the requirement for collecting qualifying financial information from the user, and allowing the lessor to view the qualifying financial information, provides a separate basis for patentability. Neither Forward nor Good teaches or suggests anything of the kind. In both systems, if the lessor is to obtain such information at all, he does this when he meets with the potential tenant.

The Examiner asserted that the additional limitations presented in claim 25 would have been obvious to implement in Forward, and provides some reasoning as to why such modifications would have been beneficial. The Examiner will appreciate, however, that such reasoning needs evidentiary support. The rejection is over the prior art. The prior art utterly lacks any teaching or suggestion of "collecting, from the user, qualifying financial information; and allowing the lessor to view the qualifying financial information of the user". Since the prior art provides no evidentiary support for the modifications to Forward, the idea must have come to the Examiner from somewhere.

In fact, the idea represented in claim 25 appears to have come to the Examiner only from Applicant's own disclosure. "Impermissible hindsight reconstruction" is the term that applies in situations such as this, where the motivation for the modification to the prior art and also the entire concept comes from nowhere else but Applicant's own disclosure. Even if the Examiner were to identify relevant prior art in which the limitations of claim 25 were met, it would still be necessary for the Examiner to find some convincing motivation to combine the reference with Forward.

This obviousness rejection does not amount even to a prima facie case of obviousness. The Examiner has not fulfilled his burden of coming forth with evidentiary support for his position. Applicant respectfully submits that the prior art does not teach or suggest the limitations of claim 25, taken in the light of the requirements of independent claim 21, and therefore Applicant respectfully submits that an artisan of ordinary skill would not have (and could not have) been led by the teachings of Forward, or Good, or their combined teachings to the subject matter of dependent claim 25. Applicant therefore respectfully requests the Examiner to withdraw this rejection of dependent claim 25.

Conclusion.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the

Amendment
09/933,957
Q92694

Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly invited to contact the undersigned attorney at the telephone number listed below.

Applicant herewith petitions the Director of the USPTO to extend the time for reply to the above-identified Office Action for an appropriate length of time, if necessary. Unless a check is attached, any fee due under 37 C.F.R. § 1.17(a) is being paid via the USPTO Electronic Filing System. The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

/Kelly G. Hyndman 39,234/
Kelly G. Hyndman
Registration No. 39,234

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: August 24, 2006